

Appl. No. 10/522,449
Amdt. Dated November 7, 2007
Reply to Office Action of May 7, 2007

REMARKS

A. Introduction

Claims 1-4 are pending and under consideration in the application.

In the Office Action of May 7, 2007, claims 1 and 2 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting. Claims 1-4 were rejected as obvious in view of some prior art.

In response, the rejections are traversed. The scope of the original claims has not been altered. No new matter is presented.

B. Double Patenting

Claims 1 and 2 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 11/027,147 to Fukuda et al. ("Fukuda").

An appropriate response to such a rejection is to file a terminal disclaimer in the application with the second to be allowed claims. Applicants reserve the right to file an appropriate terminal disclaimer in this or Application Serial No. 11/027,147, in whichever patent issues last.

C. Rejection under 35 USC §103(a)

Claims 1-4 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,141,556 to Matrick ("Matrick") in view of U.S. Patent No. 7,081,330 to Takamiya et al. ("Takamiya"). This rejection is traversed for at least the following reasons:

1. Claim 1

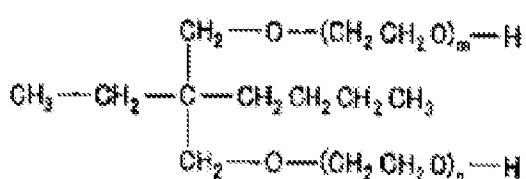
With respect to claim 1, on page 4 of the Office Action, the Examiner alleges that:

Matrick discloses a recording liquid deposited as a liquid droplet on a support for printing thereon, comprising a dye (column: 2, line: 60-65; column: 10, line 50-66), a solvent for dispersing the dye (column: 12, line: 45-65), and a surfactant containing an organic compound (column: 13, line 35-68; column: 14, line 1-30), wherein said surfactant is contained in an amount not less than 0.05 wt % and not larger than 10 wt % (column: 14, line: 30-35), and at 25 degree C., the surface

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tension is not less than 30 N/m and not larger than 60 N/m and the viscosity is not larger than 15 mPs. S (column: 15, line: 35-45).

While the Examiner then admits that Matrick does not disclose a surfactant containing an organic compound represented by the following formula:



(hereinafter "formula 1"), the Examiner then states:

Takamiya teaches that to inhibit[] the solubility of the image [], the developing solution (a recording liquid) includes the surfactant, wherein the surfactant containing an organic compound represented by the following formula (column: 10, lines 1-10).

See the Office Action, page 5. The Examiner then concludes that "it would have been obvious...to modify the surfactant of Matrick by the aforementioned teaching of Takamiya in order to have high quality image." See the Office Action, page 5.

However, Applicants respectfully submit that neither Matrick nor Takamiya, either individually or combined, disclose the Applicants' invention as recited in independent claim 1.

While the Examiner alleges Takamiya discloses formula 1, the passage referred to by the Examiner illustrates trimethylolpropyl ether EO adduct, which is a compound including $\text{CH}_2\text{O}(\text{CH}_2\text{CH}_2\text{O})_e\text{H}$. See Takamiya, Col. 10, lines 1-10. The similarly positioned portion of formula 1, as recited in independent claim 1, illustrates $\text{CH}_2\text{CH}_2\text{CH}_2\text{CH}_3$ and does not include Oxygen. As such, the Takamiyai compound is not the same of formula 1 for at least the reason that it includes Oxygen.

The Examiner appears to have overlooked additional limitations within independent claim 1 specifying integer requirements. Applicants respectfully submit that these integer requirements also render formula 1 distinct from the art of record.

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Accordingly, neither Matrick nor Takamiya, either individually or in combination, meet all of the features recited in independent claim 1. Therefore, the rejection of independent claim 1 under 35 U.S.C. §103(a) is improper, and withdrawal of this rejection and allowance of this claim are earnestly solicited.

Claims 2-4 depend from independent claim 1 and thus include all of the limitations of independent claim 1. Accordingly, dependent claims 2-4 are patentable over Matrick and Takamiya, either individually or in combination, for at least the same reasons discussed above with respect to independent claim 1.

D. Conclusion

In view of the foregoing, it is submitted that claims 1-4 are allowable and that the application is in condition for allowance. Notice to that effect is requested.

Respectfully submitted,
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